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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/502,825	02/11/2000	Kiyoshi Miyazaki	1095.1120/JDH	5726

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EXAMINER

DASS, HARISH T

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 11/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/502,825

Applicant(s)

MIYAZAKI ET AL.

Examiner

Harish T Dass

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/17/2004 has been entered.

DETAILED ACTION

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 3628

Claims 1-18 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. For example, see claim 1 "second party", "third party", "first type of fungible goods", and "second type of fungible goods" cannot be found in original specification. Applicant should note that "type of deal" (in original specification) is not same as "first type of fungible goods" and further, word "fungible" is not in original specification, original specification refers to goods, bonds, etc.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims **1-3, 5, 7-10, 11-12, 14, 16-18, and 21** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Himmelstein (PGPUB US 2002/0032643)** in view of Fraser et al (hereinafter Fraser; US 5,905,974).

Art Unit: 3628

Re. Claims 1, 9-10, 18 and 21, Himmelstein discloses orders to buy and sell (exchanging securities with special conditions or contingent orders) input means permitting input of orders to sell (to purchase) a first type (currency, commodities) of fungible goods to a second party (traders, brokers, clients, any and all clients) in the electronic market, and permitting the input of a order, the order being an order requesting, on condition of execution of an order for sale (purchase) of the first type of fungible goods, purchase (sell) a second type of fungible goods from third party (traders, brokers, clients, any and all clients), the second type of fungible goods being different from and not fungible with respect to the first type of fungible goods [see entire document particularly, Abs; Fig. 3, 5A-7E; page 1 paragraph 0001 to page 2 para. 0011; 0025-0028; page 5 para 0047], and order detecting (find) means for automatically detecting execution of an order for purchase/sale of the first type of fungible goods with respect to which the order has been placed [page 3 para 0027-0032; page 13 para 0148], and order processing means for, responsive to the detection (finds) of execution of a buy/sell order for the first type of fungible goods by said order detecting means, automatically executing the order for the second type (currency, commodities) of fungible goods [page 3 para. 0038 to page 4. para. 0039; page 5 para 0052 to page 6 para. 0053; para. 0101; para. 0025-0028], and conditioning execution of the second open order by interactively (negotiate) establishing a relation in the electronic market between the first open order and the second open order, by disallowing execution of the second open order until after execution of the first order [page 1 para 0003-0004].

Himmelstein, explicitly, does not disclose chain order. However, Fraser discloses

Art Unit: 3628

contingent orders or chain order [C4 L45-L50] to provide customized trading tools. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Himmelstein and add contingent orders (chain orders), as taught by Fraser, to provide a data processing system (computer systems) to implement a trading system (*matching* buy and sell orders) capable of high volume trading activity with minimal errors and costs, and further, provide customize trading tool to trade contingent orders, etc. Further, Applicant admits that replacement deal is a customary practice [see Specification page 4 line 27 to page 5 line 7].

Re. Claims 2, & 11 Himmelstein discloses order storing means for storing the order input from said order input means [Fig. 8; page 4 para. 0041; page 14 para. 0157], and deleting means for deleting, from said order storing means, the order with respect to which the automatic execution has been completed by said order processing means [Fig. 8; page 4 para. 039-0041; page 14 para. 0157-0159].

Re. Claims 3, & 12 Himmelstein discloses further comprising display means for selectively displaying those of the orders which include a sell / buy order for the second type of fungible goods and which satisfy a condition for sale / purchase of the second type of fungible goods [Fig. 2, 5A, 6; Abs; page 4 para. 0039; page 7 para. 0070].

Art Unit: 3628

Re. Claims 5, & 14 Himmelstein discloses further comprising price changing means for, responsive to a change in price of the first type of goods, automatically changing a price of the corresponding second type of goods of the order in an interlocked (linked) manner [Abs; page 5 para. 0047].

Re. Claims 7-8, & 16-17 Himmelstein discloses tax deferred exchange and calculating fee [page 3 para. 0033-0034; page 7 para 0070; page 11 para. 0119-0127].

Himmelstein, explicitly, does not disclose further comprising tax amount calculating means for calculating an amount of tax to be paid as-a result of the execution of the order; and notifying means for notifying parties concerned in the execution of the order of the amount of tax calculated by said tax amount calculating means and further comprising transfer means for automatically transferring a price and a tax payable as a result of the execution from one to another of accounts of parties concerned in the execution. However, it is well known to one skill in the art that taxes are calculated on taxable items (sale and trades) per IRS rules or local sale tax rules and paid regularly by consumers, therefore Himmelstein system for tax is optional which means if a customer (trader) wants to pay the tax, the system can calculate tax.

10-27-04
92

Claims 4, 6 & 13, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable ^{and Fraser} over Himmelstein ^{as applied to claims 1, 3, 10 & 12 above, in view of Nymeyer (US 3,581,072).}

Art Unit: 3628

10-27-04
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Re. Claims 4 & 13 Neither Himmelstein ^{nor} ~~or~~ Fraser, explicitly, teaches wherein said display means inhibits display of information about a buy / sell order for the second type of fungible goods (goods) included in the chain order when the chain order is placed, and displays the information after the chain order is executed. However, Nymeyer discloses this step [see entire document particularly, Abs; C1 L1 to C2 L38; C11 L50 to C12 L46; C30 L19-L55]. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to modify the teaching of Himmelstein & Fraser and include inhibiting displaying of information, as taught by Nymeyer, to control transfer of orders whenever there are no specific price order. Further the computer spread sheets are well known to one skill in the art where a user can selectively inhibits and/or protect any item (cell, row, column) from change or to hide the data from unauthorized user.

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Re. Claims 6 & 15 Neither Himmelstein ^{nor} ~~or~~ Fraser, explicitly, teaches wherein said chain order processing means performs chain order processing in series if an order placed with respect to the second type of fungible goods to be transacted is a chain order. However, Nymeyer discloses this step [Abs; C1 L1 to C2 L38; C19 L58 to C20 L23]. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to modify the teaching of Himmelstein & Fraser and include explicitly chain order (swap) orders in series, as taught by Nymeyer, to proceed serially through entire list of orders starting from # 1.

Response to Arguments

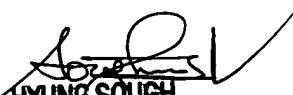
4. Applicant's arguments with respect to claims filed on 8/17/04 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR ' 1.111 (c) to consider the references fully when responding to this action.

(previously presented) US Pat 6,421,653 to May, US Pat 5,924,082 to Silverman et al, US 5,970,479 to Shepherd, US 6,112,189 to Rickard, US 5297031 to Gutterman,

(New) US 4382602 to Cusick et al, May 10, 1983 "Real Estate Game Apparatus" discloses a game for educating an agent in the basics of buying and selling property such as real estate, personal property, insurance, etc.


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